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UNITED STATES PATENT & TRADEMARK OFFICE

Application No. : 09/173,134
Title : MULTIPURPOSE RAT CAGE
Applicant : George S. Gabriel, *et al.*
Filed : October 15, 1998
TC/AU : 3643
Examiner : Son T. Nguyen
Docket No. : 364106/0176

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

REPLY BRIEF

Sir:

Applicant submits this Reply Brief in response to the Examiner's Answer dated October 3, 2005. A response is due by December 3, 2005, a Saturday, and accordingly, this Reply Brief is timely filed.

Certificate of Mailing (37 C.F.R. 1.8)

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Typed or printed name of person signing this certificate:

Jeong Eun Lee

Signature

This Reply Brief is being submitted in response to the Examiner's Answer ("the Answer") dated October 3, 2005. Applicants respectfully submit that the Examiner failed to properly address the Applicants' arguments set forth in the Applicant's Appeal Brief and failed to establish that the invention as claimed is unpatentable over the prior art.

The Examiner's Response to Argument

Examiner Has Failed To Present A Prima Facie Case of Obviousness

In section (10) entitled "Response to Argument" in the Answer, the Examiner states that the motivation for providing a floor area of a cage as claimed in the application is provided by AAPA (Applicant Admitted Prior Art) on page 1 of the specification, which the Examiner asserts teaches that, "one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied..." According to the Examiner, because ILAR guidelines set non-binding minimums for size and dimension of cages for rodents, it would have been obvious to one of ordinary skill in the art to determine a set of dimensions for the floor area of Sheaffer (U.S. Patent No. 4,989,545) that would result in a floor area of at least 80 square inches as claimed. Applicants respectfully traverse this assertion.

Applicants respectfully submit that AAPA and Sheaffer fail to provide a motivation to provide a cage having a floor having the dimensions specified in claims 1, 2 and 8 in order to accommodate a variety of species of rodents. AAPA and Sheaffer also fail to provide a motivation or suggestion to provide a cage and rack system wherein the cage has a length of less than substantially 18 inches as described in independent claims 3 and 9. Whereas AAPA discusses the possibility of varying the floor area of a cage, it does not discuss or provide a motivation or suggestion to provide the specific dimensions as claimed in order to house a variety of species of rodents. Rather, there was no practice to house a variety of sizes of animals in a single size standardized cage. The mere possibility of a modification does not suffice to establish motivation or suggestion for the modification. As the Patent and Trademark Office

Board of Patent Appeals and Interferences stated in Ex parte Dussaud, “[t]he mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification.” Ex parte Dussaud, 7 U.S.P.Q.2d 1818, 1820 (Bd. Pat. App. & Inter. 1988). Neither Sheaffer nor AAPA suggest the desirability of the dimensions of the cage and rack as claimed and therefore the Applicants respectfully maintain that the Examiner has failed to establish a motivation to modify Sheaffer and AAPA in order to obtain the invention as claimed.

In the Answer, the Examiner asserts that “the motivation for utilizing a cage level barrier cage as taught by Coiro et al. would be to provide a ventilated cage and rack system comprising cages having a useful floor space of 75 square inches... to accommodate up to five mice weighing 25 grams each, which retaining compatibility with existing wire bar lids and microbarrier tops...” See Examiner’s Answer, page 7). The Examiner, however, fails to address Applicants’ assertion that the Examiner has failed to demonstrate what reason a person skilled in the art would have for modifying Sheaffer with Coiro in order to obtain the invention as claimed. The Examiner’s statement regarding the use of a cage level barrier cage having an area of 75 square inches does not establish any motivation or reason to modify Sheaffer with Coiro to obtain the invention as claimed. In contrast, as the Examiner asserts, Coiro teaches a floor area of 75 inches and does not discuss or suggest the invention as claimed.

The Applicants respectfully submit that the Examiner fails to consider the claimed invention as a whole. According to the MPEP, “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP §2141.02 (emphasis in original). The MPEP refers to *Schenck v. Norton Corp.*, 713 F.2d 782 (Fed. Cir. 1983) in which Norton argued that the claimed invention simply takes a structure known in the art having multiple pieces and forms it into one piece, which Norton argued would have been obvious to those skilled in the art. In response, the

Federal Circuit states that Norton improperly “seeks to limit the focus of inquiry to a structural difference from the prior art and then to show that that difference *alone* would have been obvious. That effort is not proper under the statute, which requires that an invention be considered ‘as a whole’.” *Id* at 785. In *Norton*, the Federal Circuit acknowledges that the insight of eliminating the need for damping present in the prior art was “contrary to the understanding and expectations of the art,” and therefore, “the structure effectuating it would not have been obvious to those skilled in the art.” *Id*. Similarly, the present invention as claimed is a result of an insight that is contrary to the understandings and expectations of the art. The invention provides a single size standard cage and rack system for housing a variety of sizes of rodents, which is contrary to the understanding and expectation of the art that each rodent should have its own cage and rack dimensioned specifically for housing that rodent in order to comply with ILAR standards. The claimed invention is a result of the insight that such differentiated systems are not necessary, and that the cage and rack systems can be standardized while satisfying the ILAR standards. Therefore, Applicants respectfully submit that the Examiner is in error in not considering the invention as a whole.

Furthermore, the Examiner states that “one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and number of animals intended to be housed in order to provide the animals with a hygienic and humane environment.” See Examiner’s Answer, page 7. As the Examiner admits, the knowledge and practice in the art was to vary the floor area of a cage depending on the type of animal being housed therein, and therefore the Examiner identified a major difference between AAPA and the knowledge and practices of those of ordinary skill in the art and the present invention as claimed. In fact, the Examiner’s statement is consistent with the Applicants’ statement in the Applicants’ Appeal Brief that “laboratories around the world used specific cages for specific size animals, as well as the complementing

racks for those cages” See Appeal Brief, page 11. The Examiner’s assertion further supports the Applicant’s assertion that “[n]o one recognized that the problem was the fact that different sized cages were used to house different size animals, and furthermore that different rack systems were used to accommodate different sized cages.” See Appeal Brief, page 11). In contrast to the prior knowledge and practice of varying the floor area of a cage in order to render the cage suitable for each size animal, the invention as claimed helps to eliminate this process and provides a single size standardized cage that is suitable for housing a variety of sizes of animals. Accordingly, Applicants respectfully maintain that there is no motivation taught in the prior art to modify Sheaffer and AAPA to obtain the invention as claimed.

Applicants Discovered The Source Of A Problem And The Solution Thereof

In the Answer, the Examiner asserts that the Declaration under 37 CFR 1.132 filed July 21, 2005 is insufficient to overcome the rejection of claims 1-3, 8 and 9 under 35 U.S.C. §103. The Examiner erroneously contends that the claimed subject matter solved a problem that was long standing in the art. In support of his assertion, the Examiner states “there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long.” See Examiner’s Answer, page 8. The Examiner’s Answer appears to confuse the secondary consideration of discovering the source of a problem with the secondary consideration of resolving a long felt need and the failure of others. In fact, the Examiner’s statement that there is no showing that others were working on the problem supports the Applicants’ assertion that the problem solved by the claimed invention was not recognized by others.

The Examiner further mistakenly states that “[r]ecognizing a problem and discovering the cause of the problem without proof that the problem was a long standing one in the art that others have tried to work on the problem but were not successful in solving the problem do not overcome an obviousness rejections.” See Examiner’s Answer, page 8. The Examiner’s assertion would be applicable if the Applicants were arguing that the invention meets a long felt

need established by the failure of others. However, that is not the issue at hand. Rather, it is the exact opposite. Applicants have discovered an unrecognized need. Persons of ordinary skill in the art were not aware of such a problem or need. Therefore, understandably, persons of ordinary skill in the art would not, in contrast to the Examiner's assertions, have tried to work on a problem that they were unaware of. The existence of such attempts would demonstrate that the problem was indeed recognized. Therefore, the Examiner's assertion that the Applicants are required to demonstrate the attempt and failure of others to resolve the problem demonstrates that he misunderstands the issue. Moreover, the Examiner's assertion that there is no evidence that others have tried to work on the problem only supports the Applicants' statement that persons of ordinary skill in the art were unaware of the problem, and that therefore, Applicants discovered the source of the problem.

The Examiner's Comments Regarding The Declarations

Applicants respectfully submit that the Examiner mischaracterizes Nick Guise's declaration to state that Wyeth Research's choice of the One CageTM system from Lab Products is a "personal preference" and does not establish a long standing problem in the art. Mr. Guise is a customer that provided a declaration regarding the reasons his company elected to purchase the One CageTM cage and rack system. The Examiner, in his statement, ignores portions of Mr. Guise's declaration where he provides the reasons why Wyeth chose the One CageTM system. For example, in paragraph 9 of his declaration, Mr. Guise states "LPI's One CageTM System... enabled Wyeth Research to accommodate different rodent species (i.e., sizes) with the benefit of reducing inventory of cage types. Wyeth has also been able to standardize the size of each lab space due to the design and dimension of the One CageTM System." See Guise Declaration, paragraph 9. Mr. Guise went further to state that the One CageTM System's standardized caging "enhanced Wyeth Research's efficiency and laboratory and storage space utilization." See Guise Declaration, paragraph 10. More explicitly, Mr. Guise states "[o]ne reason Wyeth Research

selected and continues to purchase LPI's One Cage™ System is the cost savings we realize by not having to purchase and inventory different cage level barrier rodent cages and systems for our different rodent type needs. We can now purchase a single cage level barrier rodent cage and system for all of our rodent types." See Guise Declaration, paragraph 13. Therefore, Applicants respectfully submit that the Examiner failed to consider Mr. Guise's Declaration in full in asserting that Wyeth's choice of the One Cage™ System is merely a "personal preference".

The Examiner's Answer asserts that Neil Campbell's Declaration failed to establish a source of a problem or long felt need and failure of others. Once again, the Examiner confuses discovering the source of an unrecognized, long standing problem in the art with long felt need and the failure of others. As discussed above, lack of such evidence of long felt need and failure of others only supports the Applicants' assertion that the need was unrecognized, and the Examiner's analysis actually supports the Applicants' position.

Additionally, Applicants respectfully contest the Examiner's assertion that "Sheaffer states more than one animal being in the cage 20 and not only a single animal type or size." See Examiner's Answer, page 9. Whereas Sheaffer addresses more than one animal being present in the cage, it does not state that the cage can house more than a single type or size of animals, as the Examiner asserts. As Mr. Guise stated, the industry practice was to house one type of rodent in each cage and rack system. "Thus, manufactures provide specialized rodent cage and rack systems, with each particular rodent cage and rack system being dimensioned and configured for a specific rodent type and/or size." See Guise Declaration, paragraph 7. Therefore, the Examiner makes an unsubstantiated assumption in stating that Sheaffer states that more than one size animal can be housed in the cage.

Regarding the Declaration of Dietrich Crase, the Associate Director of Pharmacology at Advanced Medicine and the customer of the One CageTM System, the Examiner states that “although the claimed invention achieved the desirable result of reducing inventories, there is no evidence of any prior unsuccessful attempts to do so” and therefore the Declaration does not support a finding of commercial success. However, the Examiner admits that the invention achieved the desirable result of reducing inventories of clients, which supports the Applicants’ assertion that the invention achieved commercial success because of the invention as claimed and not as a result of extraneous factors, such as aggressive advertising. Furthermore, the Examiner points out that there is no evidence of prior unsuccessful attempts to solve the problem, which once again supports Applicants’ assertion that Applicants discovered the source of a problem that was unrecognized in the art. Furthermore, Mr. Crase’s Declaration and the Examiner’s characterization of the Declaration support the assertion that Applicants not only discovered the source of an unrecognized problem, but that the claimed invention resolves that issue.

CONCLUSION

Applicants respectfully maintain that (1) the Examiner failed to provide a prima facie case of obviousness by failing to demonstrate that persons of ordinary skill in the art prior to the invention had a reason or motivation to modify Sheaffer, either alone or in combination with AAPA or Coiro to obtain the invention as claimed, but rather, demonstrates evidence to the contrary; (2) the Examiner has failed to properly address Applicants’ argument that Applicants have discovered that a problem existed and also discovered the source of that problem, and that those inventive discoveries resulted in the claimed invention of the present application, but rather, the Examiner makes assertions that support the Applicants’ position; and (3) the Examiner has failed to disprove Applicants’ assertion that the invention has achieved significant

commercial success. For each of these reasons, Applicants respectfully maintain that the invention as claimed is patentable.

Applicants authorize the Commissioner to charge any new and additional fees or charges, including any fees for a petition for an extension of time, to Deposit Account No. 19-4709, if necessary.

Respectfully submitted,

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